

REMARKS

The Office communication mailed on November 30, 2007 has been reviewed carefully and the application amended in a sincere effort to place the application in condition for allowance. Accordingly, reconsideration of the rejection of the claims, and allowance of the same, are respectfully requested on the basis of the following remarks.

Upon entry of this Supplemental Amendment, Claims 1-17 and 19-20 will be pending in the application. Claim 18 has been canceled.

Support for the amendments to claim 1 can be found in paragraphs original claim 18, paragraphs [0053] to [0056] as well as the Examples. Accordingly, no issue of new matter is presented by the amendments.

Rejection of claims 1-13 and 16-19 under 35 U.S.C. 102(e)

The Examiner has rejected claims 1-13 and 16-19 under 35 U.S.C. 102(e) for allegedly being anticipated by U.S. Patent Application Publication No. 2002/0114955 (hereinafter, referred to as the '955 Patent Application) as well as U.S. Patent Application Publication No. 2002/0086115 (hereinafter, referred to as the '115 Patent Application).

The Applicants have amended claim 1 to recite the transitional phrase "consisting of" which excludes any element, step, or ingredient not specified in the claim. MPEP 2111.03.

The '955 Patent Application discloses a polyurethane formed from components comprising: (a) at least one polyisocyanate; (b) at least one active hydrogen-containing material; (c) at least one polymeric polyamine; (d) at least

one material having at least one primary or secondary amino group and at least one hydroxyl group; and (e) at least one acid functional material or anhydride having a functional group reactive with isocyanate or hydroxyl groups of other components from which the polyurethane is formed. See paragraph [0010].

In contrast to the '955 Patent Application, claim 1 of the present invention has been amended to disclose the feature that a coating composition consists of: (a) a water thinnable polyurethane wherein the polyurethane is the reaction product of the reactions consisting of: (i) a reaction between a primary and/or secondary alkanolamine with a NCO compound which yields an intermediate product, and (ii) a reaction between a cyclic carboxylic anhydride and the intermediate product; and (b) a crosslinking agent that is reactive with the water thinnable polyurethane.

Because the '955 Patent application requires the use a polymeric polyamine to form the polyurethane while the present application does not, the Applicants submit that claim 1, and the claims that depend directly or indirectly therefrom, are in condition for allowance.

Moreover, the present application is novel over the '115 Patent Application as well. The '115 Patent Application discloses that a polyurethane material having specific physical properties can be formed from: (a) at least one polyisocyanate; (b) at least one active hydrogen-containing material; (c) at least one material having at least one primary or secondary amino group and at least one hydroxyl group; and (d) at least one acid functional material or anhydride

having a functional group reactive with isocyanate or hydroxyl groups of other components from which the polyurethane is formed.

Unlike amended claim 1, the '115 Patent Application does not disclose that use of a crosslinking agent that is reactive with the polyurethane. Accordingly, the Applicants submit that claim 1, and the claims that depend directly or indirectly therefrom, are in condition for allowance.

Because the '955 Patent Application discloses the use of an additional ingredient that is excluded from amended claim 1 of the present invention and because the '115 Patent Application does not disclose use of a crosslinking agent, Applicants submit that these references can no longer be used to reject the present application under 35 U.S.C. 102(e). The Applicants, therefore, respectfully request that the rejection of these claims under 102(e) be withdrawn and that the claims claim be allowed.

Rejection of claims 14, 15, and 20 under 35 U.S.C. 103(a)

The Examiner has rejected claims 14, 15, and 20 for allegedly being unpatentable over the '955 Patent Application in view of Vandervoorde or, in the alternative, for being unpatentable over the '115 Patent Application in view of Vandervoorde.

The Applicants have attached to this Supplement Amendment an Assignment which assigns the entire interest in the present application from PPG Industries Lacke GmbH to PPG Industries Ohio, Inc.

Both the '955 Patent Application as well as the '115 Patent Application are assigned to PPG Industries Ohio, Inc. The Assignment for the '955 Patent

Application was recorded with the USPTO on February 8, 2002 and can be found on Reel/Frame 012609/0883. The Assignment for the '115 Patent Application was recorded on with the USPTO on February 8, 2002 and can be found on Reel/Frame 012613/0870.


35 U.S.C. 103(c) states that a 102(e) reference cannot be used in a 103 rejection if the 102(e) reference is owned by or subject to an obligation of assignment to the same entity that owns the pending application.

Therefore, the Applicants submit that use of the '955 and/or the '115 Patent Applications to reject claims 14, 15, and/or 20 under 35 U.S.C. 103 is improper since the present application as well as the '955 and '115 Patent Applications are owned by or subject to an obligation of assignment to the same entity, namely PPG Industries Ohio, Inc.

CONCLUSION

In light of the foregoing arguments, it is submitted that Claims 1-20 are in proper form for issuance of a Notice of Allowance and such action is respectfully requested at an early date.

Respectfully submitted,



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